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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/532,400	03/22/2000	James M Hume	042914.007001	8094

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EXAMINER

ROCHE, LEANNA M

ART UNIT PAPER NUMBER

1771

DATE MAILED: 01/14/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

A 817

Office Action Summary	Application No.	Applicant(s)	
	09/532,400	HUME, JAMES M	
	Examiner	Art Unit	
	Leanna Roche	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6,7,23,24 and 29-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6,7 is/are allowed.
- 6) ☒ Claim(s) 23,24 and 29-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's amendments filed November 5, 2002 have been entered and carefully considered. Claims 3, 4, 13, 18-22 and 25-28 have been cancelled. Claims 6, 7, 23 and 24 have been amended. Claims 29-36 have been added.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 29-36 are provisionally rejected under the judicially created doctrine of double patenting over claims 1 and 3-12 of copending Application No. 09/328328. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant

application are claiming common subject matter, as follows: Both applications are directed to a bi-layer liner having only two layers or a multi-layer liner having only three layers. The liners are comprised of a surfacer layer and one or two barrier layers as applicable. The surfacer layer being comprised of a polyurethane foam, and the barrier layers being comprised of a polyurea and isocyanate blend. The barrier layers having a cure rate of less than 60 seconds and a thickness of 80 mils or less.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 23, 24, 31, 32, 35 and 36 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant's specification and claims provide support for "cure rates of less than 60 seconds" and "thickness of less than 80 mils". The new addition of the limitations "less than **about** 60 seconds" and "less than **about** 80 mils" are not supported by the specification because in each and every instance in the original specification and claims, the upper limit for these range limitations is written as **exactly** "60 seconds" and **exactly** "80 mils". Inserting the term "about" would infer that a number that is slightly greater than these numbers may be considered within the limit of

these ranges, but there is no support in the specification or claims for a number greater than "60 seconds" or "80 mils".

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 29-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Hume et al. (USPN 5618616).

With regard to Claims 29 and 30, Hume teaches an outermost second barrier layer comprised of a polyurea and isocyanate blend (14) disposed on a polyurethane foam layer (13). The polyurethane foam layer of Hume is disposed on a first barrier layer (12). The first barrier layer (12) of Hume reads on Applicant's surface to be lined. The foam layer (13) of Hume reads on Applicant's surfacer layer disposed on a surface to be lined. The second moisture barrier layer (14) of Hume reads on Applicant's barrier layer disposed on a surfacer layer. The second barrier layer (14) of Hume in combination with the foam layer (13) of Hume reads on Applicant's bi-layer liner having only two layers.

With regard to Claims 33 and 34, Hume teaches an outermost second barrier layer comprised of a polyurea and isocyanate blend (14) disposed on a polyurethane foam layer (13) which is disposed on a first barrier layer comprised of a polyurea and

isocyanate blend (12). The first barrier layer (12) of Hume is disposed on a primed (11) substrate (20) layer. The primed (11) substrate (20) of Hume reads on Applicant's surface to be lined. The first barrier layer (12) of Hume reads on Applicant's first barrier layer disposed on a surface being lined. The foam layer (13) of Hume reads on Applicant's surfacer layer disposed on a first barrier layer. The second barrier layer (14) of Hume reads on Applicant's second barrier layer disposed on a surfacer layer. The second barrier layer (14) of Hume in combination with the foam layer (13) of Hume and the first barrier layer (12) of Hume reads on Applicant's multi-layer liner having only three layers.

With regard to Claims 31, 32, 35 and 36, the first and second barrier layers of Hume have cure rates of less than 60 seconds, and the first and second barrier layers of Hume have thicknesses of less than 80 mils.

Allowable Subject Matter

8. Claims 6 and 7 are allowed. The prior art of record does not teach or suggest a liner for concrete structures specifically comprised of two foam layers, one of the foam layers being a polyurea foam layer.

9. Claims 23 and 24 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, first paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

10. Applicant's arguments filed November 5, 2002 have been fully considered but they are not persuasive.

11. With regard to Claims 29-32, Applicant contends that "claim 29 cannot apply to a situation where a primer layer is applied to the lined surface before the surfacer and barrier layers as required by the Hume reference". This is not found persuasive because Applicant has not limited the "surface to be lined". Therefore, **any** surface having a foam surfacer layer applied to it, reads on Applicant's claimed surface to be lined. Applicant contends, "Claim 29 cannot apply to a situation where there is a first moisture barrier applied before the surfacer and barrier layers". This is also not persuasive because the first moisture barrier layer can read on Applicant's **generic** surface to be lined.

Additionally, Applicant argues, "claim 29 does not apply if there is both a primer layer and a first moisture barrier applied before the surfacer and barrier layers". Applicant's surface to be lined is completely generic. The application of a foam layer to any surface would read on Applicant's claimed "surfacer layer disposed on a surface being lined". Therefore, no matter how many additional layers are present under the foam surfacer layer, an outer barrier layer disposed on a foam surfacer layer reads on Applicant's bi-layer liner.

Applicant's argument that "a liner with any layers between the surfacer layer and the barrier layer is not covered by claim 29", is not persuasive because Hume does not teach a layer intervening between the second barrier layer and the foam layer.

Applicant's argument that, the preamble recitation of "only two layers" negates the possibility of liners having more than two layers reading on Claim 29, is not found persuasive because no matter how many additional layers are present under the foam layer, an outer barrier layer disposed on a foam layer reads on Applicant's bi-layer liner.

12. With regard to Claims 33-36, Applicant contends, "newly added claim 33 cannot apply to a liner having four or more layers, as required by Hume". This is not found persuasive because the outer second barrier layer, foam layer and inner first barrier layer of Hume read on Applicant's multi-layer liner having only three layers. The primer layer of Hume reads on Applicant's surface to be lined because Applicant has not limited the surface to be lined. Applicant contends that the added limitation "only three layers" negates the possibility of liners having more than three layers reading on claim 33. This is not persuasive of patentability because Applicant has provided no structural limitation to the "surface to be lined". The fact that Hume discloses a primer layer does not negate the fact that the first barrier layer, foam layer and second barrier layer of Hume are identical to Applicant's claimed multi-layer liner. Because the first barrier layer, foam layer and second barrier layer of Hume were previously taught for application to a surface to be lined, Hume reads directly on Applicant's claims.

Applicant argues that Hume teaches that the primer is essential to the application of the liner as a bonding element between the liner and the surface being lined. However, Applicant fails to consider the fact that a generic "surface to be lined" would include a primer layer. Additionally, it is noted that the first barrier layer, foam layer and second barrier layer of Hume are completely identical to the first barrier layer, foam

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layer and second barrier layer claimed by Applicant. Therefore, the ability of the first barrier layer to adhere to a surface other than a primer surface would be an inherent property of the first barrier layer and would be present once the first barrier layer of Hume was provided.

13. Applicant argues that the Hume patent is limited to a liner having a primer, a first barrier layer, an intermediate foam layer and a second layer, and that the present application would not be obvious to one of ordinary skill in the art because it does not utilize a primer as a means of adhesion. This argument is not found persuasive because the rejection of claims 29-36 is under 102(b) for anticipation, not 103(a) for obviousness. Hume clearly anticipates the claimed invention.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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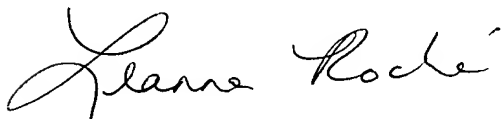
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leanna Roche whose telephone number is 703-308-6549. The examiner can normally be reached on Monday through Friday from 8:30 am to 6:00 pm (with alternate Mondays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Imr
January 7, 2003



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